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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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William Fitzpatrick

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PROSKAUER ROSE LLP

PATENT DEPARTMENT

1585 BROADWAY

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EXAMINER

CHENCINSKI, SIEGFRIED E

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/696,693	<b>Applicant(s)</b> FITZPATRICK ET AL.	
	<b>Examiner</b> SIEGFRIED E. CHENCINSKI	<b>Art Unit</b> 3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9-13 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2, 4-7,9-13 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 1, 6, 12 & 17-20 are rejected under 35 U.S.C. 112, first paragraph**, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's newly amended independent claims with the limitations of 'an alert device "operated by a third party" and 'to enable "third party" intervention' do not have support in the specification (the underlined words are the actual amended language inserted into the claims). The two instances of the use of the expression "third party" refer to "third party tools such as, Netscape Webserver" (p. 14, ll. 8-9) and "access to third party news" (p. 15, l. 25). Applicant's representative pointed to support on page 16 during the telephone interview on July 17, 2008. However, the user/monitor is part of the system provider in any reasonable understanding and does not reasonably support the understanding of a third party alert device.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claims 1, 6, 12 & 17-20 are rejected** under 35 U.S.C. 103(a) as being disclosed by Schein et al. (US Patent 6,226,623, hereafter Schein) in view of Wallman (US Patent 6,601,044 B1).

**Re. Claims 1, 12 & 17,** Schein discloses an integrated system, device and server for providing financial services, comprising:

- A global real time two way, multifaceted communications system which includes at least one alert device (Fig's 5, 6, 8, 9, 10, 11; Col. 15, ll. 12-22, 33-52. The alert device is obvious through the multiplicity of communications electronic capabilities including telephone, fax, routers, servers, electronic networks, work stations, personal computers and related security systems);
- at least one host server comprising a real-time financial customer monitoring system, the at least one host server connected to the at least one alert device and an online transaction server system over a communication system, the online transaction server system enabling to conduct customer-mediated transactions, the financial customer mediated transactions comprising orders to trade financial instruments (Brokerage services – Col. 5, ll. 3-9; Real time Transactions oversight - Col. 15, ll. 19-21, 41-52; Col. 16, ll. 11-13; broad financial services context – Col. 1, l. 19 – Col. 5, l. 9).;
- the real-time financial customer monitoring system receiving real-time data from the online financial customer transaction server system regarding the state of at least one financial customer mediated transaction conducted by a financial customer using the online transaction system, (Col. 15, ll. 21); and
- the at least one alert device presenting the real-time data as an alert to enable third party intervention in the at least one financial customer mediated transaction (Col. 22, ll. 3, 25-29)..

Schein discloses the real-time financial customer monitoring system transmitting the real-time data to the at least one alert device operated by a third party within the context described in Applicant's specification as presented on page 16, ll. 1-20, which Applicant's representative referred to for support of this limitation during the telephone

interview on the record in a mailing on July 21, 2008 and as received from Applicant on August 14, 2008. In this context the user in Applicant's invention who monitors investor transactions is associated with the provider of the investor monitoring system. As such the potentially intervening third party monitor is associated with the system provider used by the investor customer whose transaction is being monitored. Therefore Schein discloses a similar monitoring arrangement by disclosing that a user monitoring customer financial transactions including investment activities is associated with the provider of the system through which the customer is engaging in financial transactions (Col. 15, ll. 19-21, 41-52; Col. 16, ll. 11-13).

Schein does not explicitly disclose the real-time financial customer monitoring system transmitting the real-time data to the at least one alert device operated by a third party. Schein discloses a system for monitoring a broader category of financial customer transaction activities of the global Citibank real time financial services network. Schein includes the trading of equities or fixed income securities by brokerage account customers (investors) who are part of the global financial services system (see above) as a part of this unified global transaction financial system. It is obvious first that the monitoring is conducted to provide appropriate assistance to a customer such as an investor involved in a trading transaction. It is also obvious that, when appropriate, this system transmits the real-time data appropriate to a real time monitored situation through at least one alert device of the extraordinary communications capabilities available within this global system in order to transmit the alert information to the transaction customer such as an investor involved in a related transaction. Also, Wallman discloses a real time system and device for alerting an investor when certain triggering events occur (Col. 26, l. 18; Col. 31, ll. 36-38). Wallman also discloses receiving trading orders from investor customers. (Abstract). Further, Wallman discloses an alert device operated by a third party, and intervention by the third party through their alert device according to the investor's prior instructions (Abstract, ll. 6-8, 16-18; Col. 19, ll. 46-61; Col. 26, ll. 16-19; Col. 31, ll. 36-39). It would thus have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to combine the art of Schein and Wallman in order to provide an integrated system for providing financial

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services, motivated by a desire to provide an improved integrated global information system and data model that integrates customer information and makes the information accessible from remote locations (Schein, Col. 7, ll. 44-47).

**Re. Claim 6**, Schein discloses an integrated system wherein the application interface further includes a scratchpad application for moving information between applications (Inherent in MS Windows).

**Re. Claim 18**, as per the rejection of claim 17 above, it is obvious that Schein discloses wherein the central processing unit of the host server is programmed to execute the real-time investor monitoring system to receive at least one transaction order relating to the at least one investor mediated transaction as input from the alert device and to enter the transaction order into the online investor transaction server system on behalf of the investor, since the rejection of claim 17 makes this execution obvious, and Schein discloses robust computer systems for executing transaction services for customers such as for investor transactions.

**Re. Claim 19**, as per the rejection of claim 12 above, it is obvious that Schein discloses wherein the central processing unit of the alert device is programmed to transmit at least one transaction order to the real-time investor monitoring system of the at least one host server, thereby causing the real-time investor monitoring system to enter the at least one transaction order into the online investor transaction server system on behalf of the investor, the at least one transaction order relating to the at least one investor mediated transaction, since the rejection of claim 17 makes this execution obvious, and Schein discloses robust computer systems for executing transaction services for customers such as for investor transactions.

**Re. Claim 20**, as per the rejection of claim 1 above, it is obvious that Schein discloses wherein the real-time investor monitoring system receives at least one transaction order relating to the at least one investor mediated transaction as input from the alert device and enters the transaction order into the online investor transaction server system on behalf of the investor, since the rejection of claim 17 makes this execution obvious, and Schein discloses robust computer systems for executing transaction services for

customers such as for investor transactions.

**3. Claims 4, 5 and 9-11 are rejected** under 35 U.S.C. 103(a) as being disclosed by Schein in view of Wallman as applied to claim 1 above, and further in view of Clark et al.(US Patent 5,710,889, hereafter Clark).

**Re. Claim 4**, neither Schein nor Wallman explicitly disclose an integrated system wherein the real-time market data application provides real-time market data comprising at least one of: quotes, news, and historical and intraday charting. However, discloses an integrated system wherein the real-time market data application provides real-time market data comprising at least one of: quotes, news, and historical and intraday charting. (Col. 3, ll. 23-25; Col. 7, l. 28-31; Col. 10, line 49; Col. 11, line 18, a server is inherent). It would thus have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to combine the art of Schein, Wallman and Clark in order to provide an integrated system for providing financial services which includes market data, motivated by a desire to provide an improved integrated global information system and data model that integrates customer information and makes the information accessible from remote locations (Schein, Col. 7, ll. 44-47).

**Re. Claim 5**, neither Schein nor Wallman explicitly disclose an integrated system wherein the real-time market data application provides a valuation ratings for at least one financial instrument. However, Clark discloses an integrated system wherein the real-time market data application provides a valuation ratings for at least one financial instrument (Col. 24, ll. 43-49). It would thus have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to combine the art of Schein, Wallman and Clark in order to provide an integrated system for providing financial services which includes valuation ratings, motivated by a desire to provide an improved integrated global information system and data model that integrates customer information and makes the information accessible from remote locations (Schein, Col. 7, ll. 44-47).

**Re. Claim 9**, neither Schein nor Wallman explicitly disclose an integrated system further comprising an authentication system for determining user entitlements and accessing a

user preference profile. However, Clark discloses an integrated system further comprising an authentication system for determining user entitlements and accessing a user preference profile (Abstract; Col. 2, lines 48-50; Col. 5, line 63 – Col. 6, line 16; Col. 6, lines 36-47). It would thus have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to combine the art of Schein, Wallman and Clark in order to provide an integrated system for providing financial services which includes an authentication system for determining user entitlements and accessing a user preference profile, motivated by a desire to provide an improved integrated global information system and data model that integrates customer information and makes the information accessible from remote locations (Schein, Col. 7, ll. 44-47).

**Re. Claim 10**, neither Schein nor Wallman explicitly disclose an integrated system wherein the authentication system populates the application interface based on the user entitlements. However, Clark discloses an integrated system wherein the authentication system populates the application interface based on the user entitlements (Col. 5, lines 13-28; Col. 25, line 64 – Col. 26, line 6). It would thus have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to combine the art of Schein, Wallman and Clark in order to provide an integrated system for providing financial services which includes an integrated system wherein the authentication system populates the application interface based on the user entitlements, motivated by a desire to provide an improved integrated global information system and data model that integrates customer information and makes the information accessible from remote locations (Schein, Col. 7, ll. 44-47).

**Re. Claim 11**, neither Schein nor Wallman explicitly disclose an integrated system wherein the authentication system provides access to all applications using a single logon process. However, Clark discloses an integrated system wherein the authentication system provides access to all applications using a single logon process (Col. 25, line 64 – Col. 26, line 24). It would thus have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to combine the art of Schein, Wallman and Clark in order to provide an integrated system for providing financial services which includes an integrated system wherein the authentication system



provides access to all applications using a single logon process, motivated by a desire to provide an improved integrated global information system and data model that integrates customer information and makes the information accessible from remote locations (Schein, Col. 7, ll. 44-47).

**4. Claim 7 is rejected** under 35 U.S.C. 103(a) as being disclosed by Schein in view of Wallman as applied to claim 1 above, and further in view of Maggioncalda et al. (US Patent 5,918,217, hereafter Maggioncalda).

**Re. Claim 7**, neither Schein nor Wallman explicitly disclose an integrated system wherein the communication system connects a workstation to at least one host server via the Internet. However, Maggioncalda discloses an integrated system as recited by claim 1, wherein the communication system connects a workstation to at least one host server via the Internet (Col. 6, line 65).

It would have been obvious at the time of Applicant's invention to have combined the disclosures of Schein and Wallman with those of Maggioncalda for the purpose of providing an integrated financial services system which can perform a number of different finance-related functions wherein the system connects a workstation to a host server via the internet, motivated by the desire to provide an investment management system which enables an investment client to achieve superior investment performance (Maggioncalda, Col. 1, ll. 54-55).

**5. Claims 2 and 13 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Schein in view of Clark, Maggioncalda, Wolfberg and Earle as applied to claim 1 above, and further in view of Petruzzi (US Patent 5,806,049) and Fox (US Patent 5,132,899).

**Re. Claims 2 & 13**, it is obvious that the disclosures in the rejection of claim 1 above disclose or suggest an application interface displayed on a video display of the at least one alert device. Neither Schein nor Wallman explicitly disclose accessing a plurality of finance-related software applications on the at least one host server, the plurality of finance-related software applications comprising a real-time market data application, a

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financial planning application and at least one finance-related software application selected from the group consisting of: a calculator application; a client information application; an opportunities application; an investment products application; an investment research application; and an office productivity application.

However, Clark discloses an integrated system wherein the plurality of finance-related software applications further comprise at least one finance related software application selected from the group consisting of (Col. 3, lines 17-23):

- a real-time market data application (Col. 10, line 49; Col. 11, line 18);
- a client information application (Clark, Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15);
- an office productivity application (Fig. 15).

However, Clark does not explicitly disclose:

- a financial planning application;
- a calculator application;
- an investment products application;
- an opportunities application opportunities application; and
- an investment research application.

Maggioncalda discloses:

- a financial planning application (Col. 2, line 33 – Col. 3, line 63; Col. 5, lines 32-33);
- a calculator application (Col. 1, lines 31-48; Col. 8, lines 24);
- an investment products application (abstract; Col. 2, lines 12-30, 54-65).

Also, Petruzzi discloses an opportunities application (Title); and

Fox discloses an investment research application (Fox Col. 5, lines 45-53; many available, among best known available on line is Value Line).

It would have been obvious at the time of Applicant's invention to have combined the disclosures of Schein, Wallman with those of Clark, Maggioncalda, Petruzzi and Fox for the purpose of a financial advisory system that focuses individuals on the financial decisions they must make today, recommends one or more specific financial products

given these decisions, and, perhaps most importantly, illustrates the chance that their financial decisions combined with the recommended financial products will meet their needs in the future, motivated by the desire to provide an investment management system which enables an investment client to achieve superior investment performance (Maggioncalda, Col. 1, ll. 54-55).

### ***Response to Arguments***

6. Applicant's arguments filed June 16, 2008 regarding claims 1, 2, 4-7 and 9-13 and 17-20 have been fully considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. *Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).*

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Alexander Kalinowski, can be reached on (571) 272-6771.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks, Washington D.C. 20231***

or (571)273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

October 11, 2008

/Narayanswamy Subramanian/  
Primary Examiner, Art Unit 3695